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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,269	11/17/2003	Damion T. Searls	884.242US2	6473
21186	7590	11/29/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			DUONG, THO V	
			ART UNIT	PAPER NUMBER
			3744	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/716,269	SEARLS ET AL.
	Examiner Tho v. Duong	Art Unit 3744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 September 2006.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 and 17-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 17-27, 29 and 30 is/are rejected.
- 7) Claim(s) 28 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

*Response to Arguments*

Applicant's arguments filed 9/20/06 have been fully considered but they are not persuasive. Regarding the limitation of "forming an integrated circuit heat sink", applicant's argument that reference to Sotani fails to teach the limitation because Sontani disclose a rotary heat pipe instead, has been very carefully considered but is not deemed to be persuasive. The limitation of "forming an integrated circuit heat sink" does not positively require the heat sink to have a structure of an integrate circuit or an integrated circuit must be formed within. A heat sink is a device that is capable of storing and transmitting heat. The limitation of "forming an integrated circuit heat sink" does not differentiate the claimed heat sink from any other heat sink satisfying the claimed structural limitations and steps. In this case, the method of forming the Sontani's heat sink (heat pipe 10) is reasonable to read as "an integrated circuit heat sink" since it includes all the step of forming the heat sink as claimed. Regarding applicant's argument that there is written description in Elwell and Hanrahan to support a suggestion or motivation to combine Elwell with Hanrahan, has been very carefully considered but is not deemed to be persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, Elwell discloses (column 5, lines 54-56) that the particle (54) can be of any suitable shape to be mixed in the phase change material. Therefore, Elwell does not teach away from having the spherical particle. Hanrahan disclose (column 5, lines 12-15) a thermal transfer device that include a plurality of high conductive particles mixed with a phase change material similar to Elwell and further states that the particles can be a variety of shapes, for example a spherical shape, to improve a thermal conductive composite article. (column 3, lines 60-67)

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-27 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed subject matter of "each of the pair of symmetrical structure substantially identical to the other" is not supported by the disclosure. It does not appear in figure 2 that each of the pair of symmetrical structure is substantially identical each other. It is clearly that one piece of the pair has a protrusion (225) on its inner surface and fins formed on the opposite surface, while the other piece of the pair does not these feature.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2,4,5, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Elwell (US 5,315,154). Elwell discloses (figures 1,7 and column 2, lines 61-65) an apparatus comprising an integrated circuit chip (14), which is known as an integrated circuit die (See US 6,395,991); a copper conductive structure having a cavity to encapsulate a phase change material (16); the cavity including a cavity surfaces, ramp structure (side walls of 18) slopping upward from a low area (bottom flat surface) located at a center of the cavity surface; a plurality of fins (12b) formed on the conductive structure; a flat surface (12a) having a foot print larger than the surface of the die; the die (14) thermally coupled to the flat surface of the conductive structure; and a large number of particles (54) of any suitable shape intermixed with the phase change material so that it will enhance the cooling in the phase change material by either conduction or convection. Elwell discloses (figure 11-12) that the phase change material (16) is poured into the cavity through an upper hole or opening of (18). The conductive structure is sealed by closing with structure (12). The term “inject” has been defined as “to introduce into something forcefully” by Merriam Webster’s Collegiate Dictionary , 10<sup>th</sup> Edition. Therefore, pouring is considered to read as “injecting” since the examiner has to interpret the limitation as broadly as it reasonably allows.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,4 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sotani et al. (JP 358110994A). Sotani discloses (figures 1-3) a metal conductive structure (1) having a cavity; the cavity including a cavity surface sloping upward (upwardly curved walls) from a low area (bottom of surface) located at a center of the cavity surface; the cavity is partially filled with a phase change material (4) and spheres (5); the cavity is sealed and a filling tube, located at end cap (3) is closed. The term "inject" has been defined as "to introduce into something forcefully" by Merriam Webster's Collegiate Dictionary , 10<sup>th</sup> Edition. Therefore, filling a material into a closed space is considered to read as "injecting" since the examiner has to interpret the limitation as broadly as it reasonably allows.

Claims 3,21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elwell in view of Salyer (US 5,370,814). Elwell discloses substantially all of applicant's claimed invention as discussed above except for the limitation that the phase change material is a TH58 and the particles have a density about equal to the density of the phase change material. Salyer discloses (figure 1 and column 2, lines 51-59) a mixture of phase change material and particles are contained in a cavity to use as a heat sink device wherein, the particles are silica

particles (SiO<sub>2</sub>) intermixed with a phase change material of salt hydrates to form a free flowing, conformable powder-like mixture of silica and phase change material to effectively absorb heat from a heat source and minimizing any possible leak since the mixture is rather dry when it is not heated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Salyer's teaching in Elwell's device to form a free flowing, conformable powder-like mixture of silica and phase change material to effectively absorb heat from a heat source and minimizing any possible leak since the mixture is rather dry when it is not heated. As regards the limitation of TH58 and the density, Applicant discloses in the specification (page 7, lines 13-30), a few materials of phase change material such as paraffin, hydrated salts and particles such as SiO<sub>2</sub> or sand (silica) that can be used in the system and meet the requirement of TH58 and density. Therefore, Salyer's mixture of silica and salt hydrates is considered to read on the claims.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elwell in view of Hanrahan (US 5,945,217). Elwell substantially discloses all of applicant's claimed invention as discussed above except for the limitation that the particle has a spherical shape. Hanrahan discloses (figure 1 and column 5, lines 12-15) a cooling device that has a die (14) coupled to a conductive structure (10) that encapsulating intermixed particles, which have an aspect ratio 1:1 such as spherical shape to effectively dissipate heat from the die. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Hanrahan's teaching in Elwell's apparatus to effectively dissipate heat from the die. Since Elwell and Hanrahan are both from the same field of endeavor and/or analogous art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use

Hanrahan's teaching in Elwell's apparatus for the purpose of effectively dissipating heat from the die.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elwell (US 5,315,154) and Salyer in claim 21 and further in view of Hanrahan (US 5,945,217). Elwell and Salyer substantially disclose all of applicant's claimed invention as discussed above except for the limitation that the particle has a spherical shape. Hanrahan discloses (figure 1 and column 5, lines 12-15) a cooling device that has a die (14) coupled to a conductive structure (10) that encapsulating intermixed particles, which have an aspect ratio 1:1 such as spherical shape to effectively dissipate heat from the die. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Hanrahan's teaching in Elwell's apparatus to effectively dissipate heat from the die. Since Elwell and Hanrahan are both from the same field of endeavor and/or analogous art, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Hanrahan's teaching in Elwell's apparatus for the purpose of effectively dissipating heat from the die.

*Allowable Subject Matter*

Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho v. Duong whose telephone number is 571-272-4793. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tyler J. Cheryl can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tho v Duong  
Primary Examiner  
Art Unit 3744



TD

November 27, 2006